

## REMARKS

The undersigned thanks the Examiner for the interviews of September 4 and 5, 2003.

During the interview, the undersigned pointed out to the Examiner that page 18, lines 4 and 5, of the specification clearly states "non-oxidized underlayer." The Examiner said that he missed noticing this disclosure and said that in light of this disclosure the 35 USC 112, first paragraph rejection would be withdrawn. On the obviousness rejections, the Examiner suggested that the Applicants should request reconsideration.

Claims 1, 2, 6-16 and 16-20 were rejected under 35 USC 112, first paragraph. This rejection is respectfully traversed and should be withdrawn as agreed upon by the Examiner during the interview of September 5, 2003.

Claims 1, 2, 6, 7, 9, 11, 12, 16, 17, 19 and 20 were rejected as being obvious over Tanahashi in view of Suzuki and Bertero. Claims 8, 10 and 18 were rejected as being obvious over Tanahashi as modified by Bertero and Suzuki further in view of Ivett. These rejections are respectfully traversed.

Foremost, Applicants continue to maintain that the Examiner has failed to establish a *prima facie* case of obviousness as explained in the Amendment of June 20, 2003, because there is no suggestion or motivation in the cited references to combine an oxidized seedlayer directly in contact with the substrate with a non-oxidized underlayer as recited in the claims. In paragraph 9, the Examiner states that "one of ordinary skill in the art, having no knowledge of the instant invention, would have had motivation (albeit different from the instant invention) to oxidize the Cr seedlayer of Taniyama [sic, Tanahashi] via the method disclosed in Suzuki with a reasonable expectation of success." Applicants respectfully submit that the Examiner has completely missed the point. Applicants have argued, and continue to do so, that there is no

suggestion or motivation in the cited references *to combine an oxidized seedlayer directly in contact with the substrate with a non-oxidized underlayer* as recited in the claims.

On the issue of the unexpected results shown by the Applicants, the Examiner states that “the applicant has shown that the corrosion resistance and grain size distribution of a recording medium is improved by the [sic] oxidizing a seedlayer that is formed directly adjacent the substrate and below a non-oxidized underlayer, and thus is improved over that of the structure shown by Taniyama [sic, Tanahashi] alone.” Yet, the Examiner states that “the applicant has not compared the instant invention to the closes prior art, namely the combination of Taniyama [sic, Tanahashi] with Bertero and Suzuki” which in combination “results in an identical structure as that of the instant invention.” Thus, the Examiner agrees that the Applicants have shown unexpected results. Yet, the Examiner is not persuaded because the Applicants have not compared the claimed invention to a combination that “results in an identical structure as that of the instant invention.” In short, the Examiner wants the Applicants to shown unexpected results of the claimed invention over the claimed invention. How is this logically possible? In fact, MPEP 716.02(f) *prohibits* exactly what the Examiner is asking Applicants to do to show unexpected results. In particular, MPEP 716.02(f) cites *In re Chapman*, 357 F.2d 418, 148 USPQ 711 (CCPA 1966) and states: “Requiring applicant to compare claimed invention with polymer suggested by the combination of references relied upon in the rejection of the claimed invention under 35 U.S.C. 103 ‘would be requiring comparison of the results of the invention with the results of the invention.’ 357 F.2d at 422, 148 USPQ at 714.).”

In light of the above, a Notice of Allowance is respectfully solicited.

In the event that the transmittal letter is separated from this document and the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicants

petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 146712001300.

Respectfully submitted,

Dated: September 8, 2003

By: 

Raj S. Davé, Ph.D., J.D.  
Registration No. 42,465

Morrison & Foerster LLP  
1650 Tysons Boulevard  
Suite 300  
McLean, Virginia 22102  
Telephone: (703) 760-7755  
Facsimile: (703) 760-7777